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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/053,830 | 01/22/2002 | Heinrich Lang | LMX-69-CON | 6532 |

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EXAMINER

SHAFFER, RICKY D

ART UNIT

PAPER NUMBER

- 2872

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/053,830

Applicant(s)

LANG ET AL.

Examiner

Ricky D. Shafer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/304,001.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11/2 & 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election of Group IV (claims 7-10) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 2-6 and 11-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (431).

Fisher discloses a rearview mirror assembly comprising a support structure having a first part (25) and a second part (12) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm (10) having a mirror (11) and a locking mechanism (17 and/or 32) disposed on the support structure for selectively locking together the first and second parts of the support structure. Note figures 1-7 along with associated description thereof.
4. Claims 1 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bottrill ('546).

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Bottrill discloses a rearview mirror assembly comprising a support structure having a first part (18) and a second part (60) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm (22) having a mirror (12) and a locking mechanism (42,50,68,72) including key cylinders or latch members (68) disposed on the support structure for selectively locking together the first and second parts of the support structure. Note figures 1-3 along with associated description thereof.

5. Claims 1 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by McMahan ('073).

McMahan discloses a rearview mirror assembly comprising a support structure having a first part (19,35,40) and a second part (31) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm (18a) having a mirror (17) and a locking mechanism (32,66) including key cylinders or latch members (32) disposed on the support structure for selectively locking together the first and second parts of the support structure. Note figures 1-8 along with associated description thereof.

6. Claims 1 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sillmann ('925).

Sillmann discloses a rearview mirror assembly comprising a support structure having a first part (9) and a second part (19) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm (33) having a mirror (7) and a locking mechanism (22 and 25-27) including a key cylinder (25,26) or a latch member (22)

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disposed on the support structure for selectively locking together the first and second parts of the support structure. Note figures 8b and 9 along with associated description thereof.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,554,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/053,830) discloses no additional invention or discovery other than what

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was already claimed and patented in U.S. Patent 6,554,436 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

U.S. Patent ('436) discloses a rearview mirror assembly for a vehicle comprising a support structure including a first part (clamp receptacle) and a second part (insertable component) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure is disposed on a support arm having a mirror and a key activated locking mechanism disposed on the support structure for selectively locking together the first and second parts of the support structure.

As to the limitations of the claims 8 and 9, it would have been obvious or within the level of one of ordinary skill in the art at the time the invention was made to modify the key activated locking mechanism of U.S. Patent ('436) to include a typical key cylinder or rotatable latch, as is commonly used and employed in the lock art, in order to prevent unauthorized removal of the support arm and mirror.

9. Claims 1 and 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,352,231. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/053,830) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 6,352,231 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

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U.S. Patent ('231) discloses a rearview mirror assembly for a vehicle comprising a support structure including a first part (clamp reception fixture) and a second part (insertable component) for mounting the mirror assembly to a vehicle, wherein the second part of the support structure serves as a support arm for a rearview mirror and a locking mechanism disposed on the support structure for selectively locking together the first and second parts of the support structure.

As to the limitations of the claims 7 and 8, it would have been obvious or within the level of one of ordinary skill in the art at the time the invention was made to modify the locking mechanism of U.S. Patent ('231) to include a typical key activated locking mechanism, as is commonly used and employed in the lock art, in order to prevent unauthorized removal of the support arm and mirror.

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the first and second parts of the support structure.

11. The drawings are objected to because element (2), disclosed on page 5 of the specification, and elements 33 and 40, disclosed on page 7 of the specification have not been illustrated and element 20, shown in Fig. 4b, should be change to element (10). Correction is required.

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the support structure and the first and

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second parts of support structure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

13. Any inquiry concerning this communication should be directed to R. D. Shafer at telephone number (703) 308-4813.

RDS

May 30, 2003


RICKY D. SHAFER
PATENT EXAMINER
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